

REMARKS

Applicant has carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

Claims 1, 9, 11 and 14 were amended and claims 5, 8, 12 and 15 were previously canceled. Thus, claims 1-4, 6-7, 9-11, 13-14 and 16-20 are pending in the application. No new matter was added by the aforementioned amendments.

Claims 1, 9, 11 and 14 were rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the written description requirement. More specifically, the Examiner has requested Applicant to provide the exact paragraph in the specification that supports the amendment "generating a manually initiated reply to the message at the recipient." Applicant directs the Examiner to Fig. 13, box 1506, which states "recipient clicks reply "mail to" link. Additional support is found in paragraphs 0330 – 0334. For example, paragraph 330, referring to box 1504 of Fig. 12, recites "for each copy of the message delivered to each destination, the system includes an HTML "MAIL TO" link in the message together with an invitation to click on the link if the recipient wishes to receive proof of transmission or delivery of the reply". This section clearly indicates that a recipient must "click", a manual operation, on the link.

Paragraph 0334 goes even further, stating "when a recipient of the message, using a HTML enabled mail browser, clicks on the link, the browser will open the recipient's default mail client with a message already addressed to the embedded address. The recipient composes a reply and sends it to the fictitious address." Applicant respectfully submits that the subject of Fig. 13 and of paragraphs 0330 – 0334 full support "generating a manually initiated reply to the message at the recipient."

The Examiner also requested that Applicant provide the exact paragraph in the specification that supports the amendment "the manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender." Applicant respectfully submits that this amendment is fully supported by the subject matter of 0330, as stated above.

The Examiner also requested that Applicant provide the exact paragraph in the specification that supports the amendment " manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the

sender." Applicant respectfully submits that this amendment is fully supported by the subject matter in paragraphs 0330 – 0340. Together with the language cited above of paragraphs 0330 - 0334, paragraph 0340 states that "the delivery receipts are then made available to both the sender of the original message and to the recipient." Paragraph 0338 specifically states "the message is sent in a manner which allows the system to record proof of delivery and proof of content of the message," referring to the reply. Thus, paragraphs 0330 - 0340 completely disclose and support the phrase "manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender."

For the above reasons, Applicant respectfully submits that claims 1, 9, 11 and 14 satisfy the written description requirements as set forth under 35 U.S.C. §112, 1st paragraph, and respectfully requests that the rejection be withdrawn.

In paragraph 3 of the Office Action, in the section specifically directed to the Examiner's response to Applicant's previous arguments, the Examiner points to Applicant's disclosure in paragraph 0341 which states "the term recipient is also intended in the claims to include any agent of the receiver with respect to the message and attachment. Such agent may include a mail transfer agent of the recipient" to support that Examiner's position that the term "recipient" in the instant application includes any agent of the receiver, including a mail transfer agent. While that may be true in some cases where the claims are ambiguous as to who or what constitutes a "recipient," such is not the case in the pending claims of the present application. It is clear that, as fully supported by at least paragraphs 0330 – 0340 of the specification, the term "recipient" as used in the amended claims of the present application is referring to a physical entity, not a mail transfer agent which is embodied in software operating upon a computer. Accordingly, Applicant respectfully submits that the term "recipient" as used in the claims of this application is intended to mean a physical person, not software. Accordingly, the expansive definition given to Tomkow by the Examiner, while proper in relation to Tomkow's application, is not applicable to how the term "recipient" is used in the claims of the pending application.

Claims 1-4, 6-7, 9-11, 13-14 and 16-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tomkow WIPO Publication WO 01/10090 in view of Jevans WO 00/25245. Applicant respectfully traverses these rejections.

Claim 1 was amended to recite the step of "adding a "mail to" link to the message and also adding an invitation to click on the link if the recipient wishes to receive proof of transmission or delivery of the reply" and that the step of generating a manually initiated reply to the message is accomplished by clicking on the "mail to" link included in the message. Neither Tomkow nor Jevans disclose or even suggest adding a "mail to" link to a message and also adding an invitation to click on the link if the recipient wishes to receive proof of transmission or deliver of the reply, or enabling or generating a manually initiated reply by clicking on the "mail to" link included in the message, as is claimed in amended claim 1.

Further, as admitted by the Examiner, Tomkow fails to disclose a manually initiated reply. While Applicant disagrees that Jevans is analogous art, Applicant submits that while Jevans may disclose a recipient manually initiating a reply to a message, nowhere does Jevans teach or suggest clicking on a "mail to" link in the message as is claimed in amended claim 1. For these reasons, even if all the cited art were combined, one skilled in the art would still lack a method including the steps of adding a "mail to" link to the message and a recipient clicking on that link to manually initiate a reply. Moreover, the cited art does not provide any motivation or suggestion that common sense or common knowledge within the art would provide the missing steps. Accordingly, Applicant believes that amended claim 1, and the claims dependent therefrom are patentable over the cited art and request that the rejections be withdrawn and the claims be allowed.

Claim 9 was amended similarly to amended claim 1 by adding the step of "adding an HTML link in the message and also adding instructions to click on the link if the recipient wishes to receive proof of transmission or deliver of the reply" and initiating manual reply to the message by the recipient "clicking on the link in the message". As stated previously with regard to amended claim 1, neither Tomkow nor Jevans teach or suggest such steps. As admitted by the Examiner, Tomkow fails to disclose a manually initiated reply. While Applicant disagrees that Jevans is an analogous art, Applicant submits that while Jevans may disclose a recipient manually initiating a reply to a message, nowhere does Jevans teach or suggest clicking on an HTML link in the message as is claimed in amended claim 9. For these reasons, similarly to amended claim 1, even if all the cited art were combined, one skilled in the art would still lack a method including the steps of adding an HTML link to the message and a recipient clicking on that link to manually initiate a reply. Moreover, the cited art does not provide any motivation or

suggestion that common sense or common knowledge within the art would provide the missing steps. Accordingly, Applicant believes that amended claim 9, and the claims dependent therefrom are patentable over the cited art and request that the rejections be withdrawn and the claims be allowed.

Claim 11 was amended in a manner similar to claims 1 and 9. Claim 11 now recites "adding a clickable link to the message, the clickable link enabling a recipient to initiate a process for receiving proof of transmission or delivery of a reply either recipient to the message" and providing for a reply from the recipient to the message "by clicking on the link". As stated previously, none of the cited art teaches or even suggests such a combination of steps.

As admitted by the Examiner, Tomkow fails to disclose a manually initiated reply. While Applicant disagrees that Jevans is an analogous art, Applicant submits that while Jevans may disclose a recipient manually initiating a reply to a message, nowhere does Jevans teach or suggest clicking on a link added to the message as is claimed in amended claim 11. Thus, even if all of the cited art were combined, one skilled in the art would still lack a method including the steps of adding a clickable link to the message, the clickable link enabling a recipient to initiate a process for receiving proof of transmission or delivery of a reply by the recipient to the message and providing for the reply by clicking on the link, as is claimed in amended claim 11. Moreover, the cited art does not provide any motivation or suggestion that common sense or common knowledge within the art would provide the missing steps. Accordingly, Applicant believes that amended claim 11 and the claims dependent therefrom are patentable over the cited art and requests that the rejections be withdrawn and the claims allowed.

Claim 14 was amended similarly to claims 1, 9 and 11. Claim 14 has been amended to recite the additional step of "adding a clickable link in the message, the link configured to be clicked by a recipient of the message to request proof of transmission or delivery of the reply to the message sent by the recipient" and the step of "clicking on the link in the message to open a mail client with a message already addressed to an embedded address and to allow the recipient to compose a reply to the message." As stated previously with reference to the amended claims 1, 9 and 11, none of the cited art teaches or even suggests such a combination of steps.

As admitted by the Examiner, Tomkow fails to disclose a manually initiated reply. While Applicant disagrees that Jevans is an analogous art, Applicant submits that while Jevans may

disclose a recipient manually initiating a reply to a message, nowhere does Jevans teach or suggest clicking on a clickable link in the message as is claimed in amended claim 14. Even if all of the cited art are combined as suggested by the Examiner, one skilled in the art would still lack a method including the steps of adding a clickable link in the message, the link configured to be clicked by a recipient of the message to request proof of the transmission or delivery of a reply to the message sent by the recipient and clicking on the link in the message to open a mail client with a message already addressed to an embedded address and to allow the recipient to compose a reply to the message, as is claimed in amended claim 14. Moreover, the cited art does not provide any motivation or suggestion that common sense or common knowledge within the art would provide the missing steps. Accordingly, Applicant believes that amended claim 14 and the claims dependent therefrom are patentable over the cited art and requests that the rejections be withdrawn and the claims allowed.

For all of the reasons set forth above, Applicant respectfully requests that all rejections be withdrawn, and that the claims pending in the application be allowed.

CONCLUSION

Applicant has carefully reviewed the arguments presented in the Office Action and respectfully requests reconsideration of the claims in view of the remarks presented. In light of the above amendments and remarks, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Should the Examiner have any questions concerning the above amendments and arguments, or any suggestions for further amending the claims to obtain allowance, Applicant requests that the Examiner contact Applicant's attorney, John Fitzgerald, at 310-242-2667.

The Commissioner is authorized to credit any overpayment or charge any additional fees in this matter to our Deposit Account No. 06-2425.

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Respectfully submitted,

FULWIDER PATTON LLP

By: /john k. fitzgerald/
John K. Fitzgerald, Reg. No. 38,881

JKF/mlr
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201